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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,416	01/26/2001	Daniel Pellerin	13493	6341
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CHARLES N. QUINN FOX ROTHSCHILD LLP 2000 MARKET STREET, 10TH FLOOR PHILADELPHIA, PA 19103			EXAMINER MOHANDESI, JILA M	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/771,416

Applicant(s)

PELLERIN, DANIEL

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In response to applicant's request to defer consideration of the request for continued examination (RCE) and the claim amendments until a decision has been issued by the Commissioner in response to petition filed 10 October 2005, the examiner cannot defer the RCE because the filing of petition does not stay any period for reply, see 37 CFR 1.181(f) which states that the mere filling of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Therefore, the examiner will treat the RCE to avoid abandonment.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 October 2006 has been entered.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 27-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 27, line 5, claim 32, line 11, claim 33, in paragraph (i), claim 37, in paragraph (a), claim 38, paragraph (a), claim 39, paragraph (i), the limitation "one piece molded plastic", In claim 32, paragraph (a), the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses", in claim 33, paragraph (c) the limitation "generally isosceles triangular" and claim 34, 37, 39 and 40, the limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses", are new matter. These limitations are not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to the phrase "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" Applicant has no support to claim it this way because this is only one possibility and not the only possibility that the Figures depict. Furthermore, since Figures 8-11 do not show the universal cleat completely sitting in the recess and the original specification does not teach the universal cleat completely fitting into the recess, it will not be clear to one skilled in the art that the longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses since the cleat can be partially fitted into the recess and therefore, the longest side of the three sides of said base could be longer than the longest side of any of said triangular recesses.

With respect to phrase “with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses” the Figures do not teach this feature and the original specification does not contain text teaching this feature. It is not clear from the Figures as whether the longest side of said three sides of said base is shorter or longer or the same length of the shortest side of any said triangular recesses.

With respect to the phrase “with a longest side being shorter than the longest of any of said straight line sides of the recesses”, the Figures do not teach this feature and the original specification does not contain text teaching this feature, and since it is not clear where the straight line side ends and where the curved line side starts and what the actual length of the straight line side is?

### ***Specification***

5. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase “has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle” is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Contrary to applicant's arguments Figures 8-11 do not depict these new limitations.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 32, 33 and 39, recite the limitation "upstanding border",

Claim 33, recites the limitation "a third side defining an inset inboard",

There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 38, the phrase "said recesses having at least three sides defined by straight lines" is vague and indefinite. It is not clear as what part of the side is considered to be the straight side. It is not clear as where the straight sides ends and where the curved sides starts on the side of the triangle.

In claim 39, last paragraph the limitation "of said cleats are said universal cleats" is vague and indefinite. it is not clear what structure is encompassed by such language.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 27-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) and Ueda et al. (5,943,795) and Dassler (4,523,396). Tanel '292 discloses an universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole (see column 8, lines 63-66, When attaching cleat 10 to the sole 47, it is preferred that the sole 47 be formed with shallow cavities having a shape conforming to the perimeter outline (triangular in this case) of the base plate 11 and a depth generally equal to its thickness (upstanding border). The base plate 11 of a cleat 10 is placed into each cavity prior to application of the bonding material.) for receiving a cleat, the cleat comprising a generally triangular base (11) with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes (see column 9, lines 1-3, In addition, inventory management will be greatly simplified in that the same cleat 10 may be used to assemble practically all sizes of shoes. ); a grip (13) projecting from the base in a plane substantially perpendicular to the plane of the base; and a mounting hole (29) in the base, the mounting hole can have any convenient shape (column 7, line 6-8). Tanel '292 does not appear to have a threaded opening in the recess for receiving a retaining

screw to hold the cleat in place and for the mounting hole to be oblong shaped and for the specific area of the base with respect to the area of the recess.

Kawashima '693 discloses a baseball shoe having a recess (5) with threaded opening (4) therein for receiving a retaining screw (9) to hold a cleat (8) in place and allow for easier replacement of the cleat. Ueda '795 discloses that it is desirable to have the mounting hole oblong shape for connecting the cleat to the sole to allow more adjustability. See Figure 7 embodiment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel '292 for receiving a retaining screw as taught by Kawashima '693 to better secure the cleat to the sole. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the mounting hole of Tanel '292 oblong shaped as taught by Ueda '795 to allow more adjustability.

With regard to claims 27, 29, 36 and 37, the ratio of the length of the mounting hole to the width of the mounting hole as modified appears to be 8:7 to about 10:7.

With respect to the shape and size of the recess, With regard to claims, it would have been an obvious matter of design choice to modify the shape and size of the recess, since such a modification would have involved a mere change in the size and shape of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).



Dassler '396 discloses a shoe with a sole having a plurality of recesses for receiving a cleat. Dassler '396 discloses that depending on the shape of the base of the cleat there is no need for the fit between the inside wall of the openings/recesses (4) and the circumference of the base parts (5) to be too close therefore allowing the cleat to wiggle in the recess in the absence of the retaining fastener. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the area of the base of the cleat smaller than the area of the recess as taught by Dassler 396 for easier interchangeability of the cleats.

With regard to claims 28, 31 and 39-40, it appears that the area of the base is from 85% to 95% of the area of the recess, furthermore, the relationship between the area of the base and the area of the recess will depend on the type and shape of cleat being used.

### ***Response to Arguments***

12. Applicant's arguments filed 10/25/2006 and 02/14/2007 have been fully considered but they are not persuasive. Contrary to applicant's arguments Figures 8-11 do not show the new limitations considered as new matter, see above arguments. Therefore these drawings cannot be the basis for addition of descriptive material not shown by these drawings to the original written description.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).


In response to applicant's argument that the bottom of the universal cleat is sized to fit within differently shaped recess perimeters, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
April 30, 2007